

**REMARKS/ARGUMENTS**

The Office Action dated April 21, 2003 has been carefully reviewed and these remarks are responsive thereto. Claims 16 and 43 have been canceled. Claims 18, 29, and 45 have been amended. Claims 46 and 47 have been added. Support for the added claims may be found in the original application as filed, at least at paragraph 39. After entry of the present amendments, claims 1-15, 17-42, and 44-47 remain pending in this application. Reconsideration and allowance of the instant application are respectfully requested based on the above amendments and the following arguments.

**Rejections under 35 U.S.C. § 102**

Claims 1-4 and 8-45 stand rejected under 35 U.S.C. § 102(b) as being anticipated by mValue ([www.mvalue.com](http://www.mvalue.com), Screen Print 3/1/2000-8/15/2000). Applicants have canceled claims 16 and 43, rendering the anticipation rejection of these two claims moot. Applicants have amended claims 18, 29, and 45 to more clearly recite that an agreement is reached by the user and the second party, regarding use of the personal data by the secondary party.

Applicants respectfully traverse this rejection for at least the following reasons. In order to reject a claim as anticipated under 35 U.S.C. § 102, a single prior art reference must teach every aspect of the claimed invention. MPEP § 706.02. Applicants submit that the mValue reference does not teach all the claimed elements of claims 1-4, 8-15, 17-42, and 44-47.

Independent claim 1 requires the reaching of an agreement over the use of personal data by a second party or enforcing rules relating to the use of personal data by the second party, not just over or relating to the access to the personal data by the second party. Claim 1 recites, *inter alia*, "reaching an agreement, between the user and the second party, regarding use, by the second party, of any portions of the personal data." Applicants submit that this claimed element is not taught by the mValue reference. mValue does not teach reaching an agreement over use of data, only over access of data. In addition, because the mValue system does not provide identifying information to the second party, the second party is not even in a position to make any use of the information other than the limited uses described in the reference. As a result, there would be no need in the mValue system to reach an agreement over the use of the information or to monitor or

enforce rules relating to the use of the information. Therefore, this claim element is not taught or suggested by mValue.

Claims 2-4, dependent back to claim 1, are allowable for at least the same reasons as independent claim 1.

Claims 8-15, dependent back to claim 1, are allowable for at least the same reasons as independent claim 1. In addition, claim 14 recites that the steps of recording a history of actions, by the user using a user device, include "defining, by the user, of a level of a type of the actions to be recorded." Applicants submit that mValue does not teach this claim element; mValue only allows a user to turn a history recorder on or off. Therefore, claim 14 is not taught or suggested by mValue.

Independent claim 17 recites, *inter alia*, "attempting to reach an agreement with a second party, via the second party device, regarding use by the second party of any of the personal data of the user." As with claim 1, mValue does not teach or suggest attempting to reach agreement with a second party, via the second party device, regarding use of the user's personal data by the second party, and claim 17 is thus allowable for similar reasons as claim 1, above.

Amended independent claim 18 recites, *inter alia*, "a rules enforcer including in the trusted party device to enforce rules by which the personal data of the user can be accessed and used by a second party device, the rules having been agreed to by the user and a second party associated with the second party device," and is thus allowable for similar reasons as claim 1, above.

Claims 19-24, dependent back to claim 18, are allowable for at least the same reasons as amended independent claim 18. In addition, claim 24 recites in part a history recorder including a level selector by which the user, via the user device, can select one of a plurality of levels of a type of the actions to be recorded. Applicants submit that mValue does not teach this claim element; mValue only allows a user to turn a history recorder on or off. Therefore, claim 24 is not taught or suggested by mValue.

Independent claim 25 recites, *inter alia*, "a rules enforcer included in the user device to enforce rules by which portions of the personal data of the user can be accessed by the second party device, the rules having been agreed to by the user and a second party associated with the second party device, the rules including what items of the personal data are releasable to the

second party and how the items of the personal data can be used by the second party,” and is thus allowable for similar reasons as claim 1, above.

Claims 26-28, dependent back to claim 25, are allowable for at least the same reasons as independent claim 25. In addition, claim 28 recites in part a history recorder including “a level selector to select one of a plurality of levels of a type of the actions to be recorded.” mValue does not teach this claim element; mValue only allows a user to turn a history recorder on or off. Therefore, claim 28 is not taught or suggested by mValue.

Amended independent claim 29 recites, *inter alia*, “a rules enforcer to enforce rules by which items of the personal data of the user can be accessed and used by a second party device, the rules having been agreed to by the user and a second party associated with the second party device, the rules enforcer allowing access to only ones of the items, which according to the agreement, can be used by the second party,” and is thus allowable for similar reasons as claim 1, above.

Claims 30-34, dependent back to claim 29, are allowable for at least the same reasons as amended independent claim 29. In addition, claim 34 recites in part a history recorder including a level selector to select one of a plurality of levels of a type of the actions to be recorded. mValue does not teach this claim element; mValue only allows a user to turn a history recorder on or off. Therefore, claim 34 is not taught or suggested by mValue.

Independent claim 35 recites, *inter alia*, “the data storage device is arranged to have recorded therein a service profile including portions of the personal data of the user and information regarding conditions under which items within the service profile can be used by the second party,” and is thus allowable for similar reasons as claim 1, above.

Independent claim 36 recites, *inter alia*, “reaching an agreement, between the user and the second party, regarding use, by the second party, of any portions of the personal data in the personal data repository,” and is thus allowable for similar reasons as claim 1, above.

Claims 37-42, dependent back to claim 36, are allowable for at least the same reasons as independent claim 36.

Independent claim 44 recites, *inter alia*, “attempting to reach an agreement with a second party, via the second party device, regarding use by the second party of any of the personal data of the user,” and is thus allowable for similar reasons as claim 1, above.

Amended independent claim 45 recites, *inter alia*, “a rules enforcer to enforce the rules by which the personal data of the user can be accessed and used by a second party device, the rules having been agreed to by the user and a second party associated with the second party device,” and is thus allowable for at least the same reasons as claim 1, above. In addition, claim 45 recites in part, “the history recorder including a level selector to select a level of the actions to be recorded. mValue does not teach this claim element; mValue only allows a user to turn a history recorder on or off. Therefore, claim 45 is not taught or suggested by mValue.

### **Rejections under 35 U.S.C. § 103**

Claims 5-7 stand rejected under 35 U.S.C. § 103 as being unpatentable over mValue.

Applicants respectfully traverse this rejection for at least the following reasons. In order to reject a claim as obvious under § 103(a), three criteria must exist: 1) there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine the reference teachings; 2) there must be a reasonable expectation of success; and 3) the prior art reference(s) must teach or suggest all the claim limitations. *See* MPEP § 706.02 (j); *In re Vaeck*, 947 F.2d 488 (Fed. Cir. 1991).

Claim 5 adds a functional step of storing data about the user on a device operated by the user to the method of claim 1 of controlling access, use, and distribution of personal data of a user stored in a personal repository. mValue does not teach or suggest this claimed element.

Claim 6 adds a functional step of storing data about the user on a trusted party device to the method of claim 1 of controlling access, use, and distribution of personal data of a user stored in a personal repository. mValue does not teach or suggest this claimed element.

Claim 7 adds a functional step of storing data about the user in a distributed manner among a plurality of trusted party devices to the method of claim 1 of controlling access, use, and distribution of personal data of a user stored in a personal repository. mValue does not teach or suggest this claimed element.

In addition, claims 5-7 are dependent back to claim 1, and thus are allowable for at least the reasons given above for claim 1.

The Office Action indicated at para. 27 that claims 5-7 recite nonfunctional descriptive

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material. However, claims 5-7 recite functional elements (steps) of a method. That is, claims 5-7 each add a functional step of storing data on a device operated by the user, on a trusted party device, or in a distributed manner among a plurality of trusted devices, respectively, to the method of claim 1 of controlling access, use, and distribution of personal data of a user stored in a personal repository. Applicant notes that both of the cases cited to support the § 103 rejection, *In re Lowry*, and *In re Gulack*, "cautioned against a liberal use of 'printed matter rejections' under 103" because:

A "printed matter rejection" under § 103 stands on questionable legal and logical footing. Standing alone, the description of an element of the invention as printed matter tells nothing about the differences between the invention and the prior art or about whether that invention was suggested by the prior art.... [The Court of Customs and Patent Appeals], notably weary of reiterating this point, clearly stated that printed matter may well constitute structural limitations upon which patentability can be predicated.

*In re Lowry*, 32 F.3d 1579, 1583 (Fed. Cir. 1994) (quoting *In re Gulack*, 703 F.2d 1381, 1385 n. 8 (Fed. Cir. 1983)).

In the event the § 103 rejections are maintained, the examiner is requested to cite supporting evidence, as required by MPEP § 2144.03.

### **New Claims**

New claims 46 and 47 have been added.

New claim 46 recites a trusted party device for providing personal data of a user, with access rights being controlled by the user, comprising an anonymizer, a transmitter, a receiver, a data editor, a data storage device, a network interface device, a rules enforcer, and an automatic information collector, which is not taught or suggested by the cited prior art references.

New claim 47 recites a user device for providing personal data of a user, with access rights being controlled by the user, comprising an anonymizer, a data editor, a data storage device, a network interface device, a rules enforcer, and an automatic information collector, which is not taught or suggested by the cited prior art references.

Based on the aforementioned claims 1-15, 17-42, and 44-47 are in condition for allowance. Therefore, it is respectfully requested that the subject application be reconsidered and passed to issue at the Examiner's earliest possible convenience.

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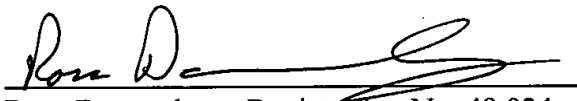
**CONCLUSION**

It is believed that no fee is required for this submission. If any fees are required or if an overpayment is made, the Commissioner is authorized to debit or credit our Deposit Account No. 19-0733, accordingly.

All rejections having been addressed, applicant respectfully submits that the instant application is in condition for allowance, and respectfully solicits prompt notification of the same. However, if for any reason the Examiner believes the application is not in condition for allowance or there are any questions, the examiner is requested to contact the undersigned at (202) 824-3153.

Respectfully submitted,  
BANNER & WITCOFF, LTD.

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